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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/713,592

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James G. Shanahan

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EXAMINER

LOVEL, KIMBERLY M

ART UNIT

PAPER NUMBER

2167

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,592

Applicant(s)

SHANAHAN ET AL.

Examiner

Kimberly Lovel

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-15 are rejected.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 3: items 302, 303, 304 and 306; Figure 5(a): item 585; Figure 5(b): items 535b, 540b and 545b; Figure 5(c): items 510c, 515c and 540c; Figure 6: items 645, 650, 655, 660, 665, 673 and 692; Figure 7: items 702, 704, 710, 711, 712, 715, 720, 721, 722, 725 and 740; Figure 8: items 800, 801 and 838; Figure 9, items 900, 901, 902, 904, 910, 920, 931, 932, 933 and 934; Figure 10: all items; and Figure 11: items 1101, 1121 and 1134. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 2 is objected to because the term "multiplexing" is misspelled.
Claim 7 is objected to because the term "thresholded" should be "threshold."
4. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application.

Claim 1 recites a process for creating a filter for selecting documents, comprising: identifying a plurality of profiles; creating a sub-filter for each of said plurality of profiles, each of said sub-filters having an input and an output; connecting each of said inputs at a single node; and combining each of said outputs.

In the above limitation, there is no physical transformation being claimed, a practical application would be established by a useful, concrete and tangible result. For it to be a tangible result, it must be more than a thought or a computation and must have a real world value rather than being an abstract idea. The invention as recited in the claim just merely combines outputs. The outputs are neither stored nor displayed and therefore it is unclear as to what kind of tangible output is obtained by these limitations. Claims 2-7, which are dependent on claim 1 fail to overcome the rejection and therefore are rejected on the same grounds as claim 1.

Claim 8 recites a process for creating a filter for selecting documents from a stream of documents, comprising: identifying a plurality of sets of documents from said stream of documents; identifying a plurality of profiles corresponding to said plurality of sets of documents; creating a plurality of sub-filters using said plurality of profiles; and combining a first one of said plurality of sub-filters with a second one of said plurality of sub-filters to create an ensemble filter.

In the above limitation, there is no physical transformation being claimed, a practical application would be established by a useful, concrete and tangible result. For it to be a tangible result, it must be more than a thought or a computation and must have a real world value rather than being an abstract idea. The invention as recited in the claim just merely creates an ensemble filter. The filter is neither stored nor displayed and therefore it is unclear as to what kind of tangible output is obtained by these limitations. Claims 9-11, which are dependent on claim 8 fail to overcome the rejection and therefore are rejected on the same grounds as claim 8.

Claim 12 recites a process for creating a filter for selecting documents from a database of documents, comprising: identifying a plurality of sets of documents from said database of documents; identifying a plurality of profiles corresponding to said plurality of sets of documents; creating a plurality of sub-filters using said plurality of profiles; and combining a first one of said plurality of sub-filters with a second one of said plurality of sub-filters to create an ensemble filter.

In the above limitation, there is no physical transformation being claimed, a practical application would be established by a useful, concrete and tangible result. For it to be a tangible result, it must be more than a thought or a computation and must have a real world value rather than being an abstract idea. The invention as recited in the claim just merely creates an ensemble filter. The filter is neither stored nor displayed and therefore it is unclear as to what kind of tangible output is obtained by these limitations. Claims 13-15, which are dependent on claim 12 fail to overcome the rejection and therefore are rejected on the same grounds as claim 12.

To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 8-15 are rejected under 35 U.S.C. 102(e) as being anticipated by US

PGPub 2003/0130993 to Mendelevitch et al (hereafter Mendelevitch et al).

Referring to claim 8, Mendelevitch et al discloses a process for creating a filter for selecting documents from a stream of documents (see [0013], lines 1-4 – classifying the documents to one or more topics is considered to represent creating a filter; a set of one or more documents is considered to represent a stream of documents), comprising:

identifying a plurality of sets of documents from said stream of documents (see [0013], lines 4-6 – dividing the documents into different topics is considered to represent identifying a plurality of sets of documents);

identifying a plurality of profiles corresponding to said plurality of sets of documents (see [0013], lines 4-6 – the plurality of topics is considered to represent a plurality of profiles);

creating a plurality of sub-filters using said plurality of profiles (see [0013], lines 6-13 – calculating confidence scores allows for the documents to be divided into a first list and a second list; the lists are considered to represent sub-filters); and

combining a first one of said plurality of sub-filters with a second one of said plurality of sub-filters to create an ensemble filter (see [0080], lines 7-9 – viewing the

lists together is considered to represent combining a first sub-filter with a second sub-filter).

Referring to claim 9, Mendelevitch et al discloses a process, as in claim 8, wherein said plurality of sets of documents further comprises:

a set of documents for training (see [0060] – training documents);

a first coherent set of documents identified from said training set of documents (see [0056] – the positive training documents are considered to represent the coherent set of documents since they represent all documents that were assigned to topic T); and

a remainder set of documents (see [0055] - the negative training documents are considered to represent the remainder set of documents since they represent all documents that are not in topic T).

Referring to claim 10, Mendelevitch et al discloses a process, as in claim 9, wherein said plurality of profiles further comprises:

a first profile corresponding to said first coherent set of documents (see [0013], lines 6-13 and [0056] – the topic to which the document belongs is considered to represent the first profile); and

a remainder profile corresponding to said remainder set of documents (see [0013], 1-4 – the other topics that the document does not belong to is considered to represent the remainder profile).

Referring to claim 11, Mendelevitch et al discloses a process, as in claim 10, wherein said plurality of sub-profiles further comprises:

a first sub-filter created using said first profile (see [0013], lines 9-13 – a first list for the topic is considered to represent a first sub-filter); and

a remainder sub-filter created using said remainder profile (see [0013], lines 9-13 – a second list is considered to represent a remainder sub-filter).

Referring to claim 12, Mendelevitch et al discloses a process for creating a filter for selecting documents from a database of documents (see [0002] and [0013], lines 1-4 – classifying the documents is considered to represent to one or more topics is considered to represent creating a filter; document database is considered to represent the database of documents), comprising:

identifying a plurality of sets of documents from said database of documents (see [0013], lines 4-6 – dividing the documents into different topics is considered to represent identifying a plurality of sets of documents);

identifying a plurality of profiles corresponding to said plurality of sets of documents (see [0013], lines 4-6 – the plurality of topics is considered to represent a plurality of profiles);

creating a plurality of sub-filters using said plurality of profiles (see [0013], lines 6-13 – calculating confidence scores allows for the documents to be divided into a first list and a second list; the lists are considered to represent sub-filters); and

combining a first one of said plurality of sub-filters with a second one of said plurality of sub-filters to create an ensemble filter (see [0080], lines 7-9 – viewing the lists together is considered to represent combining a first sub-filter with a second sub-filter).

Referring to claim 13, the claim is rejected on the same grounds as claim 9.

Referring to claim 14, the claim is rejected on the same grounds as claim 10.

Referring to claim 15, the claim is rejected on the same grounds as claim 11.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PGPub 2002/0078035 to Frank et al (hereafter Frank et al) in view of US PGPub 2003/0130993 to Mendelevitch et al.

Referring to claim 1, Frank et al discloses a process for creating a filter for selecting documents, comprising:

identifying a plurality of profiles (see [0077], lines 1-3 – a category is considered to represent a profile);

connecting each of said inputs at a single node (see [0084], lines 12-30 and Fig 2, item 810 – the icon is considered to represent the single node since the user navigates through different filters beginning with the first icon); and

combining each of said outputs (see [0084], lines 8-11 – the Boolean AND operator combines the outputs of two or more filters).

While Frank et al disclose filters for categories wherein each filter has an input and output (see [0084]), Frank et al fail to explicitly disclose the limitation of creating a sub-filter for each of said plurality of profiles, each of said sub-filters having an input and an output. Mendelevitch et al also disclose the use of categories to filter documents (see abstract) including the further limitation of creating a sub-filter for each of said plurality of profiles, each of said sub-filters having an input and an output (see [0013], lines 6-13 – calculating confidence scores allows for the documents to be divided into a first list and a second list; the lists are considered to represent sub-filters).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use process of Mendelevitch et al for creating sub-filters based on the categories with the process of Frank et al for filtering documents. One would have been motivated to do so in order to increase the efficiency of the tools available for organizing and accessing documents (Frank et al: see [0003]).

Referring to claim 2, the combination of Mendelevitch et al and Frank et al (hereafter Mendelevitch/Frank) discloses a process, as in claim 1, further comprising:

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multiplexing said outputs of said sub-filters to create a first filter output (Frank et al: see [0084], lines 8-11).

Referring to claim 3, Mendelevitch/Frank discloses a process, as in claim 2, further comprising: combining said first filter output with at least one sub-filter output to create at least one second filter output (Frank et al: see [0084], lines 8-11 – Boolean AND operator performs the combining).

Referring to claim 4, Mendelevitch/Frank discloses a process, as in claim 3, further comprising: aggregating said first filter output and said second filter output using a function (Frank et al: see [0261], lines 3-6 – the combination function).

Referring to claim 5, Mendelevitch/Frank discloses a process, as in claim 4, wherein said function is a linear function (Frank et al: see [0261], line 4 – a weighted sum is considered to represent a linear function).

Referring to claim 6, Mendelevitch/Frank discloses a process, as in claim 4, wherein said function is a weighted function (Frank et al: see [0261], line 4 – weighted sum).

Referring to claim 7, Mendelevitch/Frank discloses a process, as in claim 4, wherein said function is a thresholded aggregation function (Mendelevitch et al: see [0013] – the lists are combined based on the threshold value).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Lovel whose telephone number is (571) 272-2750. The examiner can normally be reached on 8:00 - 4:00.

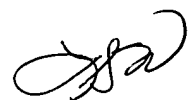
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kimberly Lovel
Examiner
Art Unit 2167

kml
2 August 2006


JOHN COTTINGHAM
SUPERVISORY PATENT EXAMINER
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3 August 2006